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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,623	08/19/2003	Janos Szamosi	157096	4463

38598 7590 10/11/2006

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EXAMINER

SHEIKH, HUMERA N

ART UNIT PAPER NUMBER

1615

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/643,623	Applicant(s) SZAMOSI ET AL.	
	Examiner Humera N. Sheikh	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

*Humera N. Sheikh*  
HUMERA N. SHEIKH  
Primary Examiner  
TC-1600

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### **Status of the Application**

Claims 1-31 are pending in this action. Claims 1-31 are subject to an Election/Restriction requirement.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to a tablet, classified in class 424, subclass 464.
- II. Claims 15-29, drawn to a method of producing a tablet composition (fast dissolving granulation), classified in class 424, subclass 466.
- III. Claims 30 and 31, drawn to a placebo tablet, classified in class 424, subclass 488.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06).

In the instant case, the Group I invention is distinct from the Group II invention. Group I (Claims 1-14) is drawn to a tablet, which is not a fast-dissolving tablet, whereas, in contrast, the Group II (Claims 15-29) tablet is a fast-dissolving tablet. The different groups would be capable of supporting a separate patent within the art, as also evidenced by their different classification. Thus, the groups would have different issues regarding patentability and enablement. Art

anticipating Group I would not anticipate or necessarily render obvious Group II. The different groups require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. This creates an undue search burden upon the Examiner.

The Group I invention is distinct from the Group III invention. Group I (Claims 1-14) is drawn to a tablet, whereas, Group III (Claims 30 & 31) is drawn to a placebo tablet. Group I invention requires the presence of an active ingredient, whereas, in contrast, the Group III invention does not require presence of any active ingredient. The different groups would be capable of supporting a separate patent within the art, as also evidenced by their different classification. Thus, the groups would have different issues regarding patentability and enablement. Art anticipating Group I would not anticipate or necessarily render obvious Group III. The different groups require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. This creates an undue search burden upon the Examiner.

The Group II invention is distinct from the Group III invention. Group II (Claims 15-29) tablet is a fast-dissolving tablet that requires the presence of active ingredient. In contrast, Group III (Claims 30 & 31) is drawn to a placebo tablet, that is not a fast-dissolving tablet, nor does it require the presence of an active ingredient. The different groups would be capable of supporting a separate patent within the art, as also evidenced by their different classification. Thus, the groups would have different issues regarding patentability and enablement. Art anticipating Group II would not anticipate or necessarily render obvious Group III. The different groups require completely different searches in both the patent and non-patent databases, and

there is no expectation that the searches would be coextensive. This creates an undue search burden upon the Examiner.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Because the above restriction/election is complex, a telephone call to applicants to request an oral election was not made. See MPEP 812.01

Applicant is also reminded that a 1-month (not less than 30 days) shortened statutory period will be set for response when a written restriction is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### **Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (571) 272-0604. The examiner can normally be reached on Monday through Friday from 8:00A.M. to 5:30P.M., alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Humera N. Sheikh

Primary Examiner

Art Unit 1615

October 01, 2006

*Humera N. Sheikh*  
TC-1600

*hns*